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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,267	06/12/2001	L. Garren Du	12587-015001	3522

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EXAMINER	
WORJLOH, JALATEE	
ART UNIT	PAPER NUMBER
3685	

NOTIFICATION DATE	DELIVERY MODE
04/19/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary	Application No.	Applicant(s)	
	09/879,267	DU ET AL.	
	Examiner	Art Unit	
	Jalatee Worjloh	3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *1, 4-6, 56-75* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-6 and 56-75* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-6 and 56-75* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/28/2009*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 28, 2009 has been entered.

2. Claims 1, 4-6, 56-75 are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 4-6, and 56-75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 1 recites "computer-implemented method"; however, it is unclear where the computer implementation takes place. Thus, in order to overcome this rejection, please include structure (e.g. computer, machine, device) within the claim's body.

6. Claim 1 recites the limitation "obtaining data that identifies unprotected digital content which is stored at a digital content manager" in line 3. There is insufficient antecedent basis for this limitation in the claim. When was the digital content stored?

7. Claims 1, 60 and 68 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: invoking the digital content publication module.

8. Claim 1 recites the limitation "the public information" in line 14. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 60 recite the limitation "obtaining data that identifies unprotected digital content which is stored at a digital content manager" in lines 6-8. There is insufficient antecedent basis for this limitation in the claim. When was the digital content stored?

10. Claim 60 recites the limitation "the public information" in line 17. There is insufficient antecedent basis for this limitation in the claim.

11. Claim 68 recites the limitation "obtaining data that identifies unprotected digital content which is stored at a digital content manager" in line 4. There is insufficient antecedent basis for this limitation in the claim. When was the digital content stored?

12. Claim 68 recites the limitation "the public information" in line 15. There is insufficient antecedent basis for this limitation in the claim.

13. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

14. Claims 1, 4-6, and 56-75 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Particularly, Claims 1, 60 and 68 recite "protecting the unprotected digital content by one or more processors and the digital content publication module, further comprising storing the protected digital content *without providing the protected digital content to the digital rights manager*" and obtaining data that indicates that the rights label has been registered with the digital rights manager, from the digital rights manager; however, the specification does not provide support for this feature. If Applicants disagree, please indicate where these features are described.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

16. Claims 1, 4-6, 56, 58 and 60-64, 66, 68, 69-72 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6226618 to Downs et al. ("Downs") in view of U.S. Publication No. 2009/0265278 to Wang et al. ("Wang").

Referring to claims 1 and 56, Downs discloses obtaining data that identifies unprotected digital content which is stored at a digital content manager and which has been selected by a content publisher for distribution or publication; obtaining data from the digital content manager that causes a digital content publication module of the digital content publication system to be invoked (see col. 18 table, step 121); responsive to invoking the digital content publication

module, receiving the unprotected digital content and metadata associated with the unprotected digital content form the digital content manager (see col. 18 table, step 122); providing an interface for allowing the content publisher to enter publication information associated with the unprotected digital content; receiving the publication information associated with the unprotected digital content from the content publisher , using the interface, the public information comprising distribution information that identifies one or more content distributors selected to distribute the digital content (see col. 18 table, step 124; col. 9, lines 31-36); protecting the unprotected digital content by one or more processors and the digital content publication module, further comprising storing the protected digital content without providing the protected digital content to the digital rights manager (see col. 18 table, step 125; col. 9, lines 48-51); and providing the protected digital content to a customer of the content distributors (see col. 19 table, step 148). Downs does not expressly disclose sending a rights label including the metadata and the publication information to a digital rights manager; obtaining data that indicates that the rights label has been registered with the digital rights manager, from the digital rights manager; providing data to the content distributors to indicate that the content distributors can retrieve the rights label from the digital rights manager, wherein the rights label comprises and extensible Rights Markup Language (XrML) rights label. Wang discloses the missing elements of Downs (see paragraphs [0037] & [0075]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Downs to include the feature of Wang. One of ordinary skill in the art would have been motivated to do this because the rights label prevents unauthorized usage of the content by specifying the usage rights that are available to an end-user (see paragraph [0032] of Wang).

Referring to claims 4 and 69, Downs discloses the digital content includes at least one of streaming video content, music content, graphic content, print content, sound content, or audio content (see col. 6, lines 45-46).

Referring to claims 5 and 70, Downs discloses the metadata includes at least one of a name, length, publisher, location, or description associated with the digital content (see col. 9, lines 21-25).

Referring to claims 6 and 71, Downs discloses the publication information further comprises at least one of pricing, rights, or catalog information associated with the digital content (see col. 9, lines 33-35).

Referring to claims 58 and 74, Downs discloses the method wherein the obtaining data from the digital content manager further comprises receiving a hypertext transfer protocol (HTTP) request (see col. 77, lines 6-14; col. 68, lines 40-42).

Claims 60 and 64 are rejected on the same rationale as claims 1 and 56, respectively.

Claims 61-63 are rejected on the same rationale as claims 4-6, respectively.

Claim 66 is rejected on the same rationale as claim 58.

Claims 68 and 72 rejected on the same rationale as claims 1 and 56 above.

17. Claims 57, 59, 60, 67, 73 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs and Wang as applied to claim 1 above, and further in view of U.S. Publication No. 2002/0107809 to Biddle et al. ("Biddle").

Referring to claim 57, Downs discloses the digital content publication module (see claim 1 above). Downs does not expressly disclose the module include an active serer page (ASP). Biddle discloses an active server page in a licensing management system (see paragraph [0051]).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Downs to include an ASP. One of ordinary skill in the art would have been motivated to do this because ASP is a specification for dynamically created Web pages.

Referring to claim 59, Downs in view of Wang disclose the method of claim 1. Downs does not expressly disclose providing the interface further comprises populating fields of the interface with at least a portion of the metadata. Biddle discloses populating fields (see paragraph [0057]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Downs to apply the concept Biddle. One of ordinary skill in the art would have been motivated to do this because it saves time by automatically completing the fields.

Claims 65 and 73 are rejected on the same rationale as claim 57 above.

Claims 67 and 75 are rejected on the same rationale as claim 59.

Conclusion

18. The claim recites the functional language for. Applicant is reminded that functional recitation(s) using the word "for" or other functional language ("to be", "to enter" etc.) have been considered but given less patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative

difference in the steps of the claim.).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 10:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and 571-273-6714 for Non-Official /Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jalatee Worjloh/
Primary Examiner, Art Unit 3685